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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,700	12/04/2007	Thomas Kruse	06-554	3091
34704 7590 09/23/2010 BACHMAN & LAPOINTE, P.C. 900 CHAPEL STREET SUITE 1201 NEW HAVEN, CT 06510				
EXAMINER				
MOORE, MARGARET G				
ART UNIT		PAPER NUMBER		
1796				
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09/23/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/593,700

**Applicant(s)**

KRUSE ET AL.

**Examiner**

Margaret G. Moore

**Art Unit**

1795

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 to 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

1. Applicants' amendment has overcome the issues raised in paragraphs 1 to 4 of the previous office action. The amendment also overcomes the rejections over Anthony and Grulke et al. previous made. Applicants' amendment to claims 15, 41 and 42 raise the necessity for the new grounds of rejection as found below.

2. Claim 16 is objected to because of the following informalities: The language "the binder exhibits an the object temperature..." is confusing. The "the" appears to be misplaced. Appropriate correction is required.

3. Claims 41 to 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to enable such a two part composition. The Examiner can find anything that would enable the skilled artisan to make such a particular two part composition in light of the teachings of the specification.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1 to 12, 14, 16 to 32, 35 to 38 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Herber et al.

The teachings over Herber et al., and how they apply against the instant claims, were noted in the previous office action. This rejection relies on the rationale of record. As such the rationale for this rejection will not be repeated. Applicants' traversal has been considered but is not deemed persuasive.

Applicants have placed the limitation of previous claim 5 into claim 1. The Examiner notes that claim 5 was rejected as being anticipated by Herbert et al.

Applicants traverse this rejection by stating that no such binder "c" is needed in the present claims. Applicants' open language "including" allows for such a binder.

Since the claims do not exclude "c", this argument carries no weight. In fact, note that "c" is within the breadth of the particles in instant claim 7.

Applicants also argue that Herber does not teach a binder having the properties of claim 5. The Examiner had previously drawn attention to the examples starting on column 7. The hydroxy functional silicone will not liberate any alcohol and there is no alcohol in these coatings. It is unclear why applicants would think that such a coating composition will liberate alcohol, let alone an amount more than 10% by weight. The slight amount of V (an amino triethoxysilane) will not liberate enough alcohol to be outside the claimed range (including the more limited range of instant claim 5).

In view of this the claims remain anticipated by the prior art.

6. Claims 13, 15, 33, 34, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herber et al.

For claims 13, 33, 34 and 39, applicants rely on the alleged novelty of claim 1 in overcoming this rejection. Since that is not sufficient (as noted supra) these rejections are maintained.

For amended claim 15 (which was previously not sufficiently clear for prior art examination) the Examiner notes that adjusting the amount of silica in the composition of Herber et al., in an effort to optimize the properties associated therewith, would have been well within the skill of the ordinary artisan, rendering this claimed ratio obvious. See for instance the wide weight range as found on column 2, lines 12 to 17, in Herbert.

7. Claims 1 to 7, 10, 16, 18 to 31, 35, 40 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Strader.

The teachings of Strader and how they apply against the instant claims, were noted in the previous office action. This rejection relies on the rationale of record. As such the rationale for this rejection will not be repeated. Applicants' traversal has been considered but is not deemed persuasive.

Applicants note that the binder in Strader includes an acrylate component as a film forming resin. Such a resin is not excluded from the instant claims, though, and as

such this has no bearing on the novelty of the claims. Applicants also state that the solid silicone resin in Strader is not usable in an aqueous binder. Applicants do not support this position, though, and the Examiner notes that Strader is directed to an aqueous coating composition. Thus applicants' position that a solid silicone resin is precluded by claim 1 is not persuasive.

Furthermore, with regard to the requirement of a specific level of alcohol release, the Examiner notes that the various silicone resins in Strader contain only alcohol groups and as such will not liberate any alcohol during curing.

In view of this the claims remain anticipated by the prior art.

8. Claims 1 to 5, 7 to 11, 13, 16 to 20, 22 to 28 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Chikuni et al.

The teachings in Chikuni et al. and how they apply against the instant claims, were noted in the previous office action. This rejection relies on the rationale of record. As such the rationale for this rejection will not be repeated. Applicants' traversal has been considered but is not deemed persuasive.

Applicants argue that Chikuni use alcohol as a solvent. Patentees do not require an alcohol, though, and the specific teaching of ketones and esters as preferred organic solvents contradict applicants' argument. Applicants also argue that no photocatalyst is called for or needed by the binder of the present invention. Again note that applicants' claims use "open" language that allows for such a photocatalyst. It is also embraced by the particles in claim 7.

In view of this the claims remain anticipated by the prior art.

9. Claims 1 to 7, 10, 16, 18 to 25, 27, 28, 31, 35, 40 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Saad et al.

Saad et al. teach a waterborne coating composition containing a siloxane resin. This resin is prepared from chlorosilanes in the presence of water, acetone and a water immiscible solvent. Since no alkoxy groups are ever present on the Si atom, no alcohol is used in the preparation of the resin and no alcohol is present as a solvent, the result-

ing coating will not liberate any alcohol upon curing. This meets claim 1. The preparation taught on column 6, lines 20 and on, as well as in Example 1 will result in a resin meeting claims 1 to 6 and 18. Attention is also directed to the working examples which teaches and shows many of the claimed limitations.

In the working examples, the titanium dioxide meets claims 7, 10 and 35.

Column 7, lines 5 and on, teaches the limitation of claim 16.

For claim 21, note that melamine meets this requirement.

The zinc octoate catalyst and propylene glycol in the working examples meets claims 27 and 28.

For claim 40, note that the amount of coupling solvent in the working examples meets this requirement.

10. Claims 15, 37 to 39 and 41 to 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saad et al.

For claim 15, please note that adjusting the amount of siloxane and filler such that it falls within the broad ratio as claimed would have been well within routine experimentation of the teachings of Saad et al. See for instance the broad ranges disclosed on column 3, lines 51 to 53.

For claims 37 to 39, note column 5, line 9, which teaches the addition of zinc as an anti-rust agent. Adjusting the amount of such a particulate metal in an effort to optimize the properties associated therewith, as well as the resulting properties of the entire coating composition, would have been well within the skill of the ordinary artisan.

For claims 41 to 43, please note that the working examples prepare a two part composition that differs from this only in that they contain titanium dioxide rather than a particulate metal. As can be seen from the top of column 4, though, metal powder such as gold or aluminum as the pigment can be used in place of titanium dioxide. As such one having ordinary skill in the art would have found the use of such a particulate metal in the two part composition of Saad et al. to have been obvious. On the other hand, one would have been motivated to add zinc as an anti-rust agent to the pigment paste in the

working examples on Saad et al. In this manner too one having ordinary skill in the art would have found the claimed composition obvious.

The Examiner notes that the component "corrosion inhibitor for the particulate metal" is quite broad and can include an anti rust agent such as those taught on the top of column 5, as well as any additive which improves the stability, longevity or curability of the composition in Saad et al.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday, Tuesday and Friday, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/  
Primary Examiner, Art Unit 1795

mgm  
9/20/10